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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/817,297	04/02/2004	Gregory H. Bearman	52316/JWP/IC766	1886
23363	7590	08/26/2009		
CHRISTIE, PARKER & HALE, LLP			EXAMINER	
PO BOX 7068			AFREMOVA, VERA	
PASADENA, CA 91109-7068				
			ART UNIT	PAPER NUMBER
			1657	
			MAIL DATE	DELIVERY MODE
			08/26/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/817,297

**Applicant(s)**

BEARMAN ET AL.

**Examiner**

Vera Afremova

**Art Unit**

1657

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 14, 17-25 and 29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14, 17-25 and 29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S5108)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Claims 14, 17-25 and 29 as amended (12/10/2008) are pending and under examination.

#### ***Drawings***

The objection to drawings as applied to figure 6 (amendment 12/10/2008) and 7 (originally filed) have been withdrawn in view of amendments and arguments (12/10/2008).

However, the last amendment to Figure 3 (as filed on 12/10/2008) was not required and it appears to be unnecessary. The original figure 3 demonstrates “analog-to-digital converter 58” (ADC 58) as described on page 6 of as-filed specification. Figure 3 is an “alternative embodiment of the invention” (page 6, line 11). Thus, substitution of ADC 44 for ADC 58 is improper or it might be considered as introduction a new matter in future prosecution. It is suggested to cancel and/or to delete the amendment to the Figure 3 as filed on 12/10/2008.

Thus, in the instant office action the drawing 3 is objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: ADC 44 belong to another or alternative embodiment as explained above.

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not

accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

The amendment filed 6/07/2004 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention.

The added material which is not supported by the original disclosure is as follows: All text presented on page 2 of 4 and on page 3 of 4 of papers filed on 6/07/2004 does not belong to the instant application. The text of amendment corresponds neither by sense nor by place of insertion to the instant specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14, 17-25 and 29 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Recktenwald et al (US 4,745,285) in view of Dabiri et al (US 5,871,628) as explained in the prior office action.

See office action mailed on 7/10/2008.

***Response to Arguments***

Applicant's arguments filed on 12/10/2008 have been fully considered but they are not persuasive.

With regard to claim rejected under 35 U.S.C. 103(a) as being unpatentable over Recktenwald et al (US 4,745,285) in view of Dabiri et al (US 5,871,628) applicants' main argument is that Dabiri et al (US 5,871,628) fails to teach or suggest an analyzer operative to "quantitatively" determine an intensity contribution to the fluorescence as recited in pending claim 14 (response page 9). Upon review it is noted found particularly true and/or persuasive because the system of the cited patent US 5,871,628 clearly encompasses measurements, collection and processing of intensity of various fluorescent dyes or various fluorescently-tagged groups ("excitable markers" as claimed) and because the system of the cited patent US 5,871,628 comprises an analyzer or processor that uses a "linear unmixing operation" software (col. 11, lines 45-65) to calculate the "weighting factors" or to determine the respective "weights" of each fluorescently-tagged groups, thereby, "quantitatively determine an intensity contribution to the fluorescence" from each fluorescently-tagged groups ("excitable markers") within the broadest meaning of the pending claims and specification (page 7 and figure 6).

No claims are allowed.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vera Afremova whose telephone number is (571) 272-0914. The examiner can normally be reached from Monday to Friday from 9.30 am to 6.00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon P. Weber, can be reached at (571) 272-0925.

The fax phone number for the TC 1600 where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology center 1600, telephone number is (571) 272-1600.

Vera Afremova

August 24, 2009

/Vera Afremova/

Primary Examiner, Art Unit 1657